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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,554	07/20/2004	Steven Lundberg	684001US9	4361
21186	7590	07/18/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			KOPPIKAR, VIVEK D	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,554	Applicant(s) LUNDBERG, STEVEN	
	Examiner Vivek D. Koppikar	Art Unit 3626	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/20/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/20/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>all received</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-60 have been examined in this application. This communication is the first action on the merits. The Information Disclosure Statement (IDS) statement filed on September 19, 2005 has also been acknowledged.

Claim Objections

2. Claim 41 is objected to because of the following informalities: On line 10 of claim 41, "on e" should be "one". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-60 are rejected under 35 U.S.C. 101 because even though the claims recite functionally descriptive material (e.g. billing steps/procedures) this material is not tangibly embodied. Specifically, it is not clear what the billing steps entail and if they involve the use of any structural components or if they are performed manually. As the claims are currently written the steps could be performed by humans without the aide of any structural components, devices or machines.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-8, 17-18, 27-28, 37-38, 47-48 and 57-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

Art Unit: 3626

distinctly claim the subject matter which applicant regards as the invention. In these claims it is not clear what entity the step of “requesting that the out-of-pocket cost be paid at a future time” is directed to (e.g. law firm client or financing organization).

Clarification and/or correction is required. For the purposes of examination, the examiner will interpret these claims to mean that the above mentioned step is directed towards a law firm client which authorizes the law firm to pay the out-of-pocket costs.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over “How to Control Your Company’s Legal Costs” by Harry J. Maue (hereinafter referred to as Maue) in view of US Patent Number 5,970,478 to Walker.

(A) Maue and Walker collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses for their clients or that the law firm arranges to pay for a plurality of out-of-pocket costs for one or more clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (an entity) (Walker: Col. 4, Ln. 50-52—Notation “30”) arranging to pay a plurality of out-of-pocket costs for one or more clients; the law firm billing one of the clients a separate charge in relation to a particular respective out-of-pocket cost wherein the separate charge is based substantially on a possible cost of

Art Unit: 3626

financing a loan to cover payment of the out-of-pocket cost; wherein the respective charge is determined substantially at the same time the firm arranges to pay the out-of-pocket cost (Walker: Figures 4-55 and Col. 5, Ln. 39-51); and further wherein the actual charge assessed the client is substantially based on when the client actually reimburses the law firm for the out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note(1): The credit is the amount of money the law firm has to incur for the client's out of pocket expense and this is the amount that incurs a finance charge). (Note(2): Walker teaches that interest is charged on an unpaid balance of an amount—the amount representing unpaid bills (out-of-pocket) expenses. Walker teaches that the finance charge is based on an interest rate and the examiner takes the position that an interest rate by its very definition means that a finance charge which is dependent on an interest rate increases as the time duration that the bill remains unpaid increases. Therefore, if there are two separate clients in Walker with unpaid balances but the amount of time that their balances remain unpaid are different than their finance charges will be different (separate). Furthermore, Maue does not teach that the expenses incurred on behalf of a client which are initially paid for by a law firm and thus financed by the law firm, incur a finance charge. However, it is well known in the art that a party who pays an expense on behalf of another party applies a finance charge to the unpaid balance that the other party owes in order to offset the time value of money.)

Art Unit: 3626

(B) As per claim 2, in Maue the out-of-pocket cost is a fee paid to a government (Maue: Page 3, Paragraph 1). (Note: Maue does not expressly states that the government agency is the Patent and Trademark office, however, when Maue states that attorneys file motions on behalf of clients the examiner interprets these motions to include documents such as petitions which are frequently filed with a government patent and trademark office.)

(C) As per claim 3, in Walker the out-of-pocket cost is paid by a transfer of funds from the law firm to a third party (e.g. merchant) (Walker: Col. 1, Ln. 14-18). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(D) As per claim 4, the combined teachings of Maue in view of Walker do not teach or suggest that the out-of-pocket cost is financed by a financing organization independent of a law firm, however, the examiner takes Official Notice that this feature is well known in the financial services industry and that it is equivalent to a credit card company. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Maue to include this above recited feature with the motivation of providing the law firm or organization incurring the out-of-pocket expenses with a means of paying bills on time without considering their own cash flow.

(E) As per claim 5, in Walker the separate charge is determined prior to a transfer of funds to pay the out-of-pocket costs (Note: The examiner takes the position that these “separate” charges are standard provisions in the credit card industry and are expressed to the consumer (credit account user) in Walker as per the terms of the credit card agreement.) (Walker: Col. 3, Ln. 21-23 and Col. 7, Ln. 38-Col. 8, Ln. 21). The

Art Unit: 3626

motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(F) As per claim 6, Maue in view of Walker do not teach that the step of arranging to pay the out-of-pocket cost comprises issuing a check to pay the out-of-pocket expense, however, the examiner takes Official Notice that making a payment by a check is well-known and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Maue with this aforementioned feature with the motivation of having a means to pay bills without having to worry about having to handle and/or deal with paper currency.

(G) As per claims 7-8, in the combined teachings of Maue in view of Walker the client (i.e. credit account customer) authorizes the another entity (e.g. credit card company or entity using a credit card company to pay costs) to pay out-of-pocket costs at a future time (e.g. once the out-of-pocket expenses are incurred by the law firm client or customer) (Walker: Col. 1, Ln. 11-19). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(H) As per claims 9-10, in Walker the substantially the same time comprises the same day as arranging to pay the out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6).

(Note: In Walker the finance charge on any given amount is based on an interest rate which is expressed to the client (customer) when they sign up for a credit account as noted in claim 5 above. Therefore the examiner takes the position that the customer already has information on the finance charge at substantially the same time they (client or customer) arrange for the credit card company (or the law firm using the credit card

Art Unit: 3626

company) to pay the out-of-pocket costs and, therefore, this time is within the same billing period (within a month) that the client (customer) arranges to have the out-of-pocket expenses paid.

(I) As per claim 11, Maue and Walker collectively teach a method comprising:

Maue teaches the concept that law firms incur “out-of-pocket” expenses for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (an entity) (Walker: Col. 4, Ln. 50-52—Notation “30”) arranging to pay a plurality of out-of-pocket costs for one or more clients; the law firm incurring a finance charge in relation to a particular respective out-of-pocket cost wherein the finance charge (e.g. a late fee) is based substantially on a cost of financing a loan to cover payment of the out-of-pocket cost; the law firm determining a disbursement amount to bill to the law firm client to recover at least a portion of the finance charge (Walker: Col. 5, Ln. 62-Col. 6, Ln. 6), wherein the disbursement amount is determined substantially at the same time the firm arranges to pay the out-of-pocket costs (Walker: Col. 5, Ln. 62-Col. 6, Ln. 6), and is based on an assumption of when the law firm client will reimburse the law firm for the out-of-pocket costs (Walker: Col. 5, Ln. 62-Col. 6, Ln. 6); and further wherein the actual finance charge assessed the client is based on when the client reimburses the law firm for the out-of-pocket cost, wherein the client reimburses the law firm at a time earlier than that assumed to determine the disbursement amount (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6).

(Note: Although not expressively stated in Walker finance charges (separate charges) or late fees are charged to customers/clients in order to recover the cost of paying the

Art Unit: 3626

customer's/clients' out-of-pocket expenses because a credit card company or law firm paying these expenses on behalf of a client must borrow money to pay for these expenses and pay for the time value of money. The examiner takes Official Notice on this feature and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue in view of Walker with this aforementioned feature with the motivation of having a means to recuperate the time value of money from the client/customer.)

(J) As per claims 12-20, these claims repeat features previously addressed in the rejection of claims 2-10, above, respectively, and are rejected on the same basis.

(K) As per claim 21, Maue and Walker collectively teach a method comprising:

Maue teaches the concept that law firms incur "out-of-pocket" expenses for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (entity) arranging to pay a plurality of out-of-pocket costs for one or more clients (Walker: Col. 4, Ln. 50-52—Notation "30"); and the law firm billing one of the clients a separate charge in relation to a particular respective out-of-pocket cost wherein the separate charge is based substantially on an estimate of a cost of financing a loan to cover payment of the out-of-pocket cost (Walker: Col. 3, Ln. 19-21 and Col. 5, Ln. 57-Col. 6, Ln. 6), wherein the respective charge is determined substantially at the same time the firm arranges to pay the out-of-pocket cost (Walker: Figure 4 and Col. 5, Ln. 57-Col. 6, Ln. 6), and the estimate is based on an assumption of when the client will reimburse the law firm for the out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6); and further wherein the actual charge assessed the client is based

Art Unit: 3626

on when the client reimburses the law firm for the out-of-pocket cost and is less than the estimate of the cost of financing (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6).

(Note: Although not expressly stated in Walker finance charges (separate charges) or late fees are charged to customers/clients in order to recover the cost of paying the customer's/clients' out-of-pocket expenses because a credit card company or law firm paying these expenses on behalf of a client must borrow money to pay for these expenses and pay for the time value of money. The examiner takes Official Notice on this feature and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue in view of Walker with this aforementioned feature with the motivation of having a means to recuperate the time value of money from the client/customer.)

(L) As per claims 22-30, these claims repeat features previously addressed in the rejection of claims 2-10, above, respectively, and are rejected on the same basis.

(M) As per claim 31, Maue and Walker collectively teach a method comprising:

Maue teaches the concept that law firms incur "out-of-pocket" expenses for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (entity) arranging to pay a plurality of out-of-pocket costs for one or more clients (Walker: Col. 4, Ln. 50-52—Notation "30"); and the law firm assessing the one or more clients a separate expense in relation to each respective out-of-pocket cost wherein the separate expense is based substantially on a cost of financing a loan to cover payment of the out-of-pocket cost (Walker: Col. 3, Ln. 19-21 and Col. 5, Ln. 57-Col. 6, Ln. 6); wherein the law firm bills at least one of the one or more clients a

Art Unit: 3626

first disbursement amount to obtain payment for a respective separate expense, the first disbursement amount determined substantially at the same time the firm arranges to pay the associated out-of-pocket cost (Walker: Figure 4; Col. 3, Ln. 19-21; Col. 5, Ln. 57-Col. 6, Ln. 6), wherein the first disbursement amount is based on an assumption of when the at least one client will reimburse the law firm for the associated out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6); and further wherein the law firm assesses the at least one client a second disbursement amount instead of the first disbursement amount, wherein the second disbursement amount is based on when the at least one client actually reimburses the law firm for the out-of-pocket expense (Walker: Col. 3, Ln. 19-21 and Col. 5, Ln. 57-Col. 6, Ln. 6). (Note: The examiner takes the position that a second disbursement amount, as the claims are stated, could refer to an amount of zero. In Walker, no late fees (disbursement amounts) are charged if the client (customer) pays the bill on time (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6).

(Note: Although not expressively stated in Walker finance charges (separate charges) or late fees are charged to customers/clients in order to recover the cost of paying the customer's/clients' out-of-pocket expenses because a credit card company or law firm paying these expenses on behalf of a client must borrow money to pay for these expenses and pay for the time value of money. The examiner takes Official Notice on this feature and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue in view of Walker with this aforementioned feature with the motivation of having a means to recuperate the time value of money from the client/customer.)

Art Unit: 3626

(N) As per claims 32-40, these claims repeat features previously addressed in the rejection of claims 2-10, above, respectively, and are rejected on the same basis.

(O) As per claim 41, Maue and Walker collectively teach a method comprising:

Maue teaches the concept that law firms incur “out-of-pocket” expenses for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (entity) arranging to pay a plurality of out-of-pocket costs for one or more clients (Walker: Col. 4, Ln. 50-52—Notation “30”); and the law firm assessing at least one of the one or more clients a separate expense in relation to each respective out-of-pocket cost wherein the separate expense is based substantially on a cost of financing a loan to cover payment of the out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln.6); wherein the law firm assesses the at least one client a first charge if the client reimburses the law firm for a particular one of the out-of-pocket costs within an assumed time frame (Walker: Col. 5, Ln. 57-Col. 6, Ln.6), and further wherein the law firm instead assesses the at least one client a charge less than the first charge if the at least one client reimburses the law firm for the particular one of the out-of-pocket costs sooner than the assumed time frame (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6); and wherein the law firm determines the first charge at substantially at the same time the firm arranges to pay the out-of-pocket cost for the at least one client (Walker: Figure 4; Col. 3, Ln. 19-21 and Col. 5, Ln. 57-Col. 6, Ln. 6).

(Note: Although not expressively stated in Walker finance charges (separate charges) or late fees are charged to customers/clients in order to recover the cost of paying the customer’s/clients’ out-of-pocket expenses because a credit card company or law firm

Art Unit: 3626

paying these expenses on behalf of a client must borrow money to pay for these expenses and pay for the time value of money. The examiner takes Official Notice on this feature and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue in view of Walker with this aforementioned feature with the motivation of having a means to recuperate the time value of money from the client/customer.)

(P) As per claims 42-50, these claims repeat features previously addressed in the rejection of claims 2-10, above, respectively, and are rejected on the same basis.

(Q) As per claim 51, Maue and Walker collectively teach a method comprising:
Maue teaches the concept that law firms incur “out-of-pocket” expenses for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a law firm (entity) arranging to pay a plurality of out-of-pocket costs for one or more clients (Walker: Col. 4, Ln. 50-52—Notation “30”); and the law firm assessing the one or more clients a separate expense in relation to each respective out-of-pocket cost wherein the separate expense is based substantially on a cost of financing a loan to cover payment of the out-of-pocket cost (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6) ; wherein the law firm assesses at least one of the one or more clients a first charge if the at least one client reimburses the law firm for a particular one of the out-of-pocket costs within an assumed time frame (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6), and further wherein the law firm alternately assesses the at least one client a charge less than the first charge if the at least one client reimburses the law firm for the particular one of the out-of-pocket costs sooner than the assumed time frame (Walker: Col. 5, Ln. 57-Col. 6, Ln. 6); and

Art Unit: 3626

wherein the law firm presents the first charge to the at least one client using an end-of-month monthly billing cycle for the month in which the particular one of the out-of-pocket costs is incurred (Walker: Col. 2, Ln. 8-13). (Note: Walker does not teach presenting monthly bills to the client which include expenses incurred on behalf of that client during the billing cycle month, however, the examiner takes Official Notice that this feature is well known in the art and at the time of the invention one of ordinary skill in the art would have modified the combined teachings of Walker in view of Maue with the aforementioned feature with the motivation of providing the law firm (entity) with a periodic means of communicating incurred charges to a client). (Note: Although not expressly stated in Walker finance charges (separate charges) or late fees are charged to customers/clients in order to recover the cost of paying the customer's/clients' out-of-pocket expenses because a credit card company or law firm paying these expenses on behalf of a client must borrow money to pay for these expenses and pay for the time value of money. The examiner takes Official Notice on this feature and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue in view of Walker with this aforementioned feature with the motivation of having a means to recuperate the time value of money from the client/customer.)

(R) As per claims 52-60, these claims repeat features previously addressed in the rejection of claims 2-10, above, respectively, and are rejected on the same basis.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Art Unit: 3626

US Patent Numbers 6,070,150, 5,950,174, 5,465,206, 5,794,221 and WO 96/10235 are all related to financing various expenses.

Non-Patent Documents: "Owing Patients an explanation" and "Modern Healthcare" relate to out-of-pocket expenses which are incurred by professionals on behalf of clients.

10. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM. If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely, 
Vivek Koppikar

6/21/2006


C. LUKE GILLIGAN
PATENT EXAMINER